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FAX (408) 971-4660

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Date: August 8, 2006	Phone Number	Fax Number
To: Examiner Chai		(571) 273-8300
From: Kevin J. Zilka		

Docket No.: NAIIP456/00.163.01

App. No: 09/785,222

Total Number of Pages Being Transmitted, Including Cover Sheet: 11

Message:

Please deliver to Examiner Chai.

Thank you,

Kevin J. Zilka

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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) NAI1P456/00.163.01	
I hereby certify that this correspondence is being facsimile transmitted to the Commissioner for Patents, Alexandria, VA 22313-1450 to fax number (571) 273-8300 on <u>August 8, 2006</u> Signature <u>April Skovmand</u> Typed or printed name <u>April Skovmand</u>		Application Number 09/785,222	Filed 02/20/2001
		First Named Inventor Lee Codel Lawson Tarbotton	
		Art Unit 2131	Examiner L. Chai
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		Signature <u>Kevin J. Zilka</u>	
<input type="checkbox"/> applicant/inventor.		Typed or printed name <u>Kevin J. Zilka</u>	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/98)		Telephone number <u>408-971-2573</u>	
<input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>41,429</u>		Date <u>August 8, 2006</u>	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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REMARKS

The Examiner has objected to the specification as allegedly failing to provide proper antecedent basis for the claimed “data ... received from said computer virus scanner logic for simultaneously performing additional operations in parallel with said computer virus scan, said additional operations including identifying a request to execute a computer program associated with said computer file to be scanned for computer viruses by said computer virus scanner logic.” Applicant respectfully disagrees with such objection and points out that, in response to operation 40 of Figure 4, Figure 5 is carried out simultaneously and in parallel with subsequent operations 42-50 of Figure 4 that follow operation 40, as further evidenced by the detailed description of such figures et al. (e.g. see the Examiner’s citation, etc.). Of course, such citations (in combination with the remaining specification) are merely examples of the above claim language and should not be construed as limiting in any manner.

The Examiner has rejected Claims 1, 19, and 37 under 35 U.S.C. 112, first paragraph, as failing to comply with the written requirement. Applicant respectfully disagrees, and asserts that the claimed technique is supported, as argued above.

The Examiner has rejected Claim 1 under 35 U.S.C. 101, as being directed toward non-statutory subject matter. Applicant respectfully disagrees, and asserts that the preamble of Claim 1 positively recites “a computer program operable to control a computer” (emphasis added). Thus, a physical medium is provided for the computer program product of Claim 1.

The Examiner has rejected Claims 1, 7, 8, 10-12, 15, 19, 25, 26, 28-30, 33, 37, 43, 44, 46-48, 51, and 58-61 under 35 U.S.C. 103(a) as being unpatentable over Chi (U.S. Patent No. 6,006,329) in view of Farber et al. (U.S. Patent No. 6,415,280) in view of Greschler (U.S. Publication No. 2002/0078203). Applicant respectfully disagrees with such rejection.

With respect to each of the independent claims, the Examiner has relied Col. 3, lines 17-23 from Chi to make a prior art showing of applicant’s claimed technique where “audit data generator logic separate from said computer virus scanner logic and being triggered by

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said computer virus scanner logic prior to said generating said scan result” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpt from Chi relied upon by the Examiner merely teaches what steps are taken “[w]hen the processor 110 receives a request to scan files for viruses” (emphasis added). Specifically, the processor “... sends a request to the storage medium 130 to retrieve the data streams associated with the files that are to be scanned” (emphasis added). However, the processor requesting data streams from the storage medium fails to disclose “audit data generator logic separate from said computer virus scanner logic and being triggered by said computer virus scanner logic prior to said generating said scan result” (emphasis added), as claimed by applicant.

In addition, with respect to each of the independent claims, the Examiner has relied on Col. 3, lines 17-23 from Chi, Col. 12, lines 38-43 from Farber, and Col. 34, lines 45-62 from Farber to make a prior art showing of applicant’s claimed “identifying a request to execute a computer program associated with said computer file to be scanned for computer viruses by said computer virus scanner logic and, in response to identification of said request to execute said computer program, generating audit data identifying said computer program” (see this or similar, but not necessarily identical language in the independent claims).

Applicant respectfully asserts that the excerpt from Chi merely discloses that “the processor 110 receives a request to scan files for viruses” (emphasis added). Clearly, the mere disclosure of receiving a request to scan files for viruses fails to even suggest “identifying a request to execute a computer program associated with said computer file to be scanned for computer viruses by said computer virus scanner logic” (emphasis added), as claimed by applicant. In addition, applicant respectfully asserts that the excerpts from Farber relied upon by the Examiner teach that “the system might store the True Names of all executable applications on the system and then periodically redetermine the True Names of each of these applications to ensure that they match the stored True Names” (emphasis added). Additionally, the excerpts disclose a technique where “[t]he Verify True File mechanism verifies that a data item in a True File registry is indeed the correct data item

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given its True Name” (emphasis added). However, periodically re-determining and verifying True Names of executable applications simply fails to even suggest a technique “in response to identification of said request to execute said computer program, generating audit data identifying said computer program” (emphasis added), as claimed by applicant.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. A notice of allowance or specific prior art showing of each of the foregoing claim elements, in combination with the remaining claimed features, is respectfully requested.

Applicant further notes that the prior art is also deficient with respect to the dependent claims. For example, with respect to Claims 17, 35, and 53, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Chi, in view of Farber, in view of Greschler, in view of Hypponen (U.S. Patent No. 6,577,920). Specifically, the Examiner has relied on Col. 5, lines 62-65 from Hypponen to make a prior art showing of applicant’s claimed technique “wherein local audit data is stored upon a computer within a computer network until said computer is polled by a remote computer upon said computer network whereupon said local audit data is sent to said remote computer.”

Applicant respectfully asserts that the excerpt from Hypponen relied upon by the Examiner merely teaches that “a report is sent to the network manager 7, and also possibly to

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the remote server 17 of the software provider" (emphasis added). However, this prior art reference is deficient since the excerpt from Hypponen fails to disclose a technique "wherein local audit data is stored upon a computer within a computer network until said computer is polled by a remote computer" (emphasis added), as claimed by applicant.

In addition, with respect to dependent Claims 17, 35, and 53, the Examiner has simply dismissed the same under Official Notice. Specifically, the Examiner has stated that it would have been obvious for one of ordinary skill in the art at the time the invention was made "[for a local computer] to be polled by a remote computer upon said computer network whereupon said local audit data is sent to said remote computer." Applicant respectfully disagrees. In particular, applicant respectfully asserts that polling fails to even suggest that "local audit data is stored upon a computer within a computer network until said computer is polled by a remote computer" (emphasis added), as claimed by applicant.

Applicant thus formally requests a specific showing of the subject matter in ALL of the claims in any future action. Note excerpt from MPEP below.

"If the applicant traverses such an [Official Notice] assertion the examiner should cite a reference in support of his or her position." See MPEP 2144.03.

Further, with respect to dependent Claims 17, 35, and 53, the Examiner has rejected the same under 35 U.S.C. 103(a) as being unpatentable over Chi, in view of Farber, in view of Greschler, in view of Schlossberg et al. (U.S. Publication No. 2002/0078203). Specifically, the Examiner has relied upon paragraphs 0009 and 0061 in Schlossberg to make a prior art showing of applicant's claimed technique "wherein local audit data is stored upon a computer within a computer network until said computer is polled by a remote computer upon said computer network whereupon said local audit data is sent to said remote computer."

Applicant respectfully asserts that the excerpts from Schlossberg relied upon by the Examiner merely disclose that "[t]he Interception Unit 103 or Detection Units 105 can be

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installed on all sub-networks, which are networks of users and servers connected to the main protected network, in the protected network to monitor the traffic on the entire sub-network” (emphasis added). Further, Schlossberg discloses that “[t]hese units are constantly polled by the Management Unit 117” (emphasis added). Clearly, the mere disclosure that Interception Unit and Detection Units are constantly polled by the Management Unit fails to even suggest that “local audit data is stored upon a computer within a computer network until said computer is polled by a remote computer” (emphasis added), as claimed by applicant.